

REMARKS

Claims 10-15 and 25 are amended. Claims 1-3, 5-21, and 23-28 are pending. In view of the following remarks, Applicant respectfully requests reconsideration of the rejections.

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Examiner Interview

Applicant would like to sincerely thank Examiner Kyle Stork for discussing this application with Applicant's representative, Lance Sadler, during a telephonic examiner interview held on November 9, 2010. During the examiner interview, 10 the secondary reference Kumar (June, 2001) was discussed with respect to the priority date of February 23, 2001 for U.S. Provisional Application 60/271,035 which this application claims the benefit of. Agreement was reached that the reference Kumar did not qualify as prior art and the 103(a) rejection should be withdrawn. Applicant sincerely thanks Examiner Stork for his effort to advance 15 prosecution of this application.

§ 101 Rejections

Claims 1-3, 5-15, 23-25, and 28 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Office alleges that in 20 regards to claim 1 that "the claimed method neither provides a specific machine performing the steps, nor a transformation. Without such a machine or a transformation, the claim fails to define a statutory process" (Office Action, pg. 2).

Applicant respectfully submits that the Office is mistaken. “An applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article into a different state or thing.” *In re Bilski*, 545 F.3d 943, 961. Applicant notes,

5 however, that the Supreme Court addressed the *Bilski* case in a Slip Opinion dated June 28, 2010, entitled *Bernard L. Bilski and Rand A. Warsaw, Petitioners v.*

David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director, Patent and Trademark Office, 561 U.S. ____ (2010). In its opinion, the Court notes that:

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15 Adopting the machine-or-transformation test as the sole test for what constitutes a “process” (as opposed to just an important and useful clue) violates these statutory interpretation principles. Section 100(b) provides that “[t]he term ‘process’ means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” The Court is unaware of any “ordinary, contemporary, common meaning,” *Diehr*, supra, at 182, of the definitional terms “process, art or method” that would require these terms to be tied to a machine or to transform an article.

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The Court also notes that:

25 This Court’s precedents establish that the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101. The machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible “process.”

Thus Applicant respectfully urges the Office to consider the Supreme Court’s characterization of the machine-or-transformation test as an investigative

tool, but not the sole test for deciding whether an invention is a patent-eligible process.

Claim 1 meets the requirements of § 101, at least in part, because the method recites (emphasis added) “receiving an indication over a network, in response to a request for access to a rich media presentation by an internet browser on a **network device**, that the internet browser on the **network device** has requested access to the rich media presentation”. A network device is indeed a statutory device and accordingly for at least this reason, Applicant respectfully requests that the § 101 rejection of claim 1 be withdrawn. Claims 2-3, 5-9, 23-24, and 28 depend from claim 1 and the comments directed to claim 1 apply equally to the respective dependent claims.

The Office alleges that claim 10 “is directed toward non-functional descriptive material...[and] fails to provide a functional interrelation between the instructions stored on the computer-readable storage medium and a computing process” (Office Action, pg. 2-3). Applicant respectfully disagrees. Nonetheless, in the interest of advancing meaningful prosecution, claims 10-15 and 25 have been amended as indicated above. Accordingly, Applicant respectfully requests that the § 101 rejection of claims 10-15 and 25 be withdrawn.

§ 103 Rejections

Claims 1-3, 5-7, 9-14, 16-20, and 23-27 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,985,934 to Armstrong et.

al. (hereinafter “Armstrong”) in view of “The HotMedia Architecture: Progressive and Interactive Rich Media for the Internet”, June 2001, by Kumar et al.

(hereinafter “Kumar”). It is noted that claim 28 was not listed in the claim listing at the beginning of paragraph 5 of the Office Action, but was addressed later in pg.

- 5 8 as being rejected by a combination of Wade and Armstrong. Applicant will assume the Office intended to cite Kumar, correction is requested. Kumar has been disqualified as prior art, thus rendering the § 103(a) rejection moot.

Claims 8, 15, and 21 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Armstrong in view of Kumar and in further view of U.S.

- 10 Patent No. 6,262,724 to Crow et al. (hereinafter “Crow”). Kumar has been disqualified as prior art, thus rendering the § 103(a) rejection moot.

Applicant submits that the rejections of the pending claims have been traversed.

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Conclusion

The Application is in condition for allowance and the Applicant respectfully requests reconsideration and issuance of the present application.

Accordingly, Applicant respectfully requests that the Office issue a Notice of

- 5 Allowability. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully submitted,

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